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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/235,242	01/22/99	FRIEDRICH	W 48746

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HM12/0405

EXAMINER

STOCKTON, L

ART UNIT PAPER NUMBER

1613

4

DATE MAILED:

04/05/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~which is longer~~, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-6 are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-6 are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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## DETAILED ACTION

Claims 1-6 are pending in the application.

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The reactants and product in the claims should be singularized (ie.,  $\beta$ -

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alkoxynitrile instead of  $\beta$ -alkoxynitriles). Claims 1, 2 and 6 are indefinite because it is not clear from the phrase, "where 1 to 4 hydrogens may be independently replaced by the radicals  $R^1$  to  $R^4$ ", if the substitution is on the catalyst or on the reactant/product.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green {U.S. Pat. 4,617,154} and in view of Sullivan, III et al. {U.S. Pat. 4,231,956} and O'Lenick, Jr. et al. {U.S. Pat. 5,196,589}.

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Applicants claim a process of making a  $\beta$ -alkoxynitrile by reacting an  $\alpha,\beta$ -unsaturated nitrile with an alcohol in the presence of a diazabicycloalkene catalyst. Green teaches a process of making a  $\beta$ -alkoxynitrile and a  $\beta$ -alkylthionitrile by reacting an  $\alpha,\beta$ -unsaturated nitrile with an alcohol in the presence of a diazabicycloalkene catalyst (see columns 1 and 2). Further, Sullivan, III et al. teach additional diazabicycloalkene catalysts useful in the preparation of a  $\beta$ -alkylthionitrile (column 5, lines 13-25) and O'Lenick, Jr. et al. teach the hydrogenation process instantly claimed (column 4, lines 48-53). The difference between the process of Green and the process instantly claimed is the reaction temperature ranges.

The optimization of variables, such as pH, temperature and molar ratios, in a known process is *prima facie* obvious. *In re Boesch*, 205 USPQ 215 (1980). One skilled in the art would have been motivated to utilize the process of Green with the expectation of obtaining  $\beta$ -alkoxynitrile.

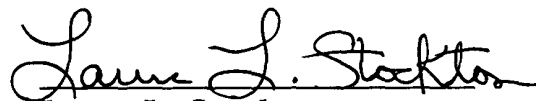
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Therefore, the claimed process would have been suggested to one skilled in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.

A handwritten signature in cursive script that reads "Laura L. Stockton".

Laura L. Stockton

Patent Examiner

Art Unit 1613, Group 1610

Technology Center 1

April 2, 1999